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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/419,798	10/18/1999	TOSHIHIKO MIURA	1004.1063/JD	1817

140 7590 03/23/2006

LADAS & PARRY  
26 WEST 61ST STREET  
NEW YORK, NY 10023

EXAMINER
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JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/419,798

Applicant(s)

MIURA ET AL.

Examiner

Monique R. Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. The amendment filed 12/27/05 has been entered. New claims 10-12 have been added.

Claims 1-12 are pending in the application.

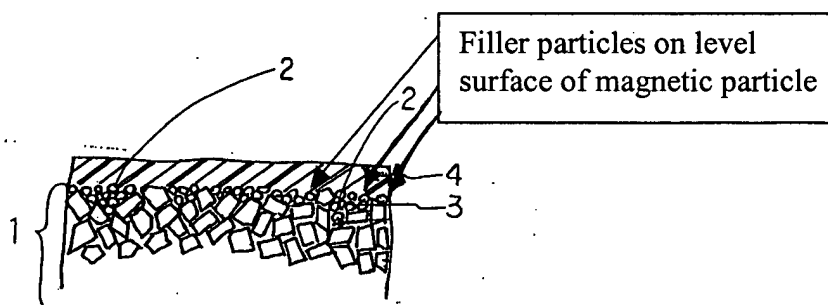
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now recites “without accumulation on level surfaces of the magnetic particles” however the original disclosure at the time of filing does not support this limitation and in fact Figure 1 shows filler particles on level surfaces of the magnetic particles (see below.)



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5. Claims 3-7 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A filling material particle size of between 0.1 and 15 microns critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). According to the specification at Page 7, “[I]n order to fill the spaces between the magnetic particles, the particle size of the filler must be within the range 0.1 to 15 microns in order to achieve the objective of a surface roughness Ra of 3 microns or less.” Hence, given the term “must”, it is evident that the recited particle size is essential to the claimed invention.

***Claim Rejections - 35 USC § 102***

6. Claims 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 09-205013 (JP’013.) JP’013 teaches a resin bonded rare earth magnet comprising a magnet body compression molded from a mixture of rare-earth transition metal alloy magnet powder 1 and a thermosetting epoxy binder, and soft metal powders embedded into the depressions or openings 2 present between the magnetic particles 1 on the face of the magnet body to flatten the front face of the magnet body, and then coated with a thin resinous coat layer such as an epoxy resin of 10 micrometers or less, preferably at least 3 micrometers, wherein JP’013 teaches that after applying the soft metal powder, the front face of the magnetic particle 1 also has part which is exposed prior to applying the resin layer 4 (0006-0008.) JP’013 specifically teaches an example utilizing FE-ND-B amorphous metal alloy powder with a mean particle diameter of 100 microns, and aluminum filler powder having a thickness of 0.1-1 micron and a mean diameter of 50 micron, wherein JP’013 further teach examples that have a surface roughness that reads upon the instantly claimed surface roughness (Examples, 0014, Table 2.)

***Claim Rejections - 35 USC § 103***

7. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '013.

The teachings of JP'013 are discussed above. Though JP'013 teach the use of soft metal powders to fill the depressions and spaces between the larger magnetic particles of the magnet body wherein portions of the magnetic particle(s) may be exposed prior to applying a resin overcoat layer, JP'013 does not specifically recite that the soft metal filler particles are only present in the depressions of the magnet body so as to cause the surface of the magnet body to be smoother. However, JP'013 does teach that the purpose of the soft metal powder is to smoothen the surface of the magnet body by filling the depressions and spaces between the magnetic particles and therefore, given the interest of conserving material, one having ordinary skill in the art at the time of the invention would have been motivated to limit the soft metal powder taught by JP'013 to only the depressions or spaces between the magnetic particles as instantly claimed.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson  
Primary Examiner  
Technology Center 1700  
March 20, 2006